

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT(S): JANG, Young-Geun

GROUP ART UNIT: 2617

APPLICATION NO.: 10/785,264

EXAMINER: KIM, Wesley LEO

FILING DATE: February 23, 2004

DOCKET: 678-1168

**FOR: MOBILE COMMUNICATION SYSTEM AND METHOD FOR
 PROVIDING PHONE NUMBER MAINTAINING SERVICE**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

In response to the Examiner's Answer mailed March 6, 2008 (the Examiner's Answer), Appellants respectfully submit that based on at least the arguments provided in the Appeal Brief of December 11, 2007 (the Appeal Brief), Claims 1, 2, 6, and 7 are patentable over *Koster* (U.S. Patent No. 6,240,293) in view of *Giuhat et al.* (U.S. Patent No. 5,881,145), and Claims 3-5 and 8-10 are patentable over *Koster* in view of *Giuhat*, further in view of *Mazzarella et al.* (U.S. Publication No. 2002/0107011 A1). The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

In the Examiner's Answer, the Examiner reiterated the rejection set forth in the Office Action mailed on March 8, 2007 (the first Office Action) and the Office Action mailed on June 11, 2007 (the Final Office Action).

In response to the first Office Action, the Final Office Action, and in the Appeal Brief, Appellants have consistently argued that the combinations of *Koster* in view of *Giuhat*, and *Koster* in view of *Giuhat*, further in view of *Mazzarella* do not teach all of the recitations in the claims. In particular, Appellants have argued that *Koster* in view of *Giuhat* fails to teach or reasonably suggest "a second MSC for determining a changed service provider of the called terminal based on the called

terminal information included in the call request signal transmitted from the first MSC,” or a second MSC, which receives a call request transmitted from the first MSC and a third MSC, which receives the call request transmitted from the second MSC, as recited in independent Claim 1.

On page 9 of the Examiner’s Answer, in the first paragraph of item (10), the Examiner states that “Appellant argues that the Examiner alleges that *Koster* does not teach ‘a second MSC for determining a changed service provider of the called terminal based on the called information included in the call request signal transmitted from the first MSC.’” However, Appellant did not make this argument in the Appeal Brief. Rather, Appellant stated that “the Examiner states that *Koster* teaches each and every limitation of Claim 1 except for a first mobile switching center (MSC) for receiving a call request signal with calling terminal information and called terminal information, determining an initial service provider of a called terminal from the called terminal information and transmitting the call request signal to a communication network formed by the determined initial service provider of the called terminal, which the Examiner states is taught by *Giuhat*.” (See first paragraph of A1 in the Appeal Brief).

Additionally, Examiner’s responses to Appellant’s consist mainly of the same responses presented in the previous Office Action, with the exception of the Examiner’s repeated assertion that “[i]n response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references,” citing *In Re Keller*. However, it is respectfully submitted that Appellant is not attacking any references individually and clearly states in all previously filed responses, as well as in the Appeal Brief, that the references alone or combination do not render the claims of the present application obvious. Additionally, it appears that the Examiner makes this assertion any time Appellant sets forth an argument regarding an individual reference, in order to rebut an Examiner’s assertion that a claim feature is taught by the reference, which is not consistent with the holding of *In Re Keller*. Accordingly, Appellant reasserts the position that the Examiner has failed to establish a *prima facie* case of obviousness of Claims 1-10 based on the combinations of *Koster* in view of *Giuhat*, and *Koster* in view of *Giuhat*, further in view of *Mazzarella*.

CONCLUSION

Appellant has shown multiple errors in the Examiner's final rejection of the claims in the present case. Therefore, based on at least the foregoing, and as the Examiner has failed to make out a prima facie case for an obviousness rejection, the rejection of Claims 1-10 must be reversed.

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.


Koster or *Giuhat* et al. or the combination thereof does not render independent Claims 1 and 6 obvious. Thus, independent Claims 1 and 6 are allowable.

Accordingly, dependent Claims 2-5 and 7-10 are allowable because of their dependence upon independent Claims 1 and 6.

The Examiner has failed to show that all of the recitations of Claims 1-10 are taught, disclosed or fairly suggested by *Koster*, *Giuhat*, or *Mazzarella*, or the combination thereof. Accordingly, the Examiner has failed to make out a prima facie case for an obviousness rejection.

Appellant respectfully requests that the Board reverses such final rejection.

Dated: April 29, 2008

By: 
Paul J. Farrell
Reg. No.: 33,494
Attorney for Appellants

THE FARRELL LAW FIRM
333 Earle Ovington Blvd., Suite 701
Uniondale, New York 11553
(516) 228-3565 (tel)
(516) 228-8475/8476 (fax)

PJF/DMO/fl